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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,833	02/12/2004	Gregory Paul Andrews	ROC920030246US1	5895
7590 Grant A. Johnson IBM Corporation, Dept. 917 3605 Highway 52 North Rochester, MN 55901-7829			EXAMINER PILLAI, NAMITHA	
			ART UNIT 2173	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/777,833	Applicant(s) ANDREWS, GREGORY PAUL	
	Examiner Namitha Pillai	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/27/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number 100 in Figure 1A (page 4, lines 3-6) and reference number 10 in Figure 1B (page 5, line 6). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because the components of Figure 1A have not been properly labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered

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and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract has been objected to for exceeding 150 words.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 7 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the specification fails to provide support for "***replacing the selected list of elements with the summary information***". The replacing feature as disclosed in the specification does not make clear the elements used in the replacing step. Based on the current disclosure, the Examiner has interpreted that the replacing involves replacing the elements within the clipboard, where the copied list of elements are replaced on the clipboard with the summary data.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite functional descriptive material but not in combination with an appropriate computer readable medium. The computer readable medium must be a physical structure, not a signal, which allows for the functionality to be carried out with a computer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4, 5, 8-10, 12-17 and 20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U. S. Patent Publication No. 2004/0049729 A1 (Penfield).

Referring to claim 1, Penfield discloses a method of displaying summary information about a list of elements and receiving a selection of at least one desired summary function (page 1, paragraph 9, lines 6-8). Penfield discloses receiving a selection of a list of elements and calculating the at least one desired summary function using the list of desired elements to generate summary information (page 1, paragraph 10, lines 1-12). Penfield discloses displaying the summary information in a results window (page 1, paragraph 10, lines 7-9).

Referring to claim 4, Penfield discloses receiving a selection of display method selection (page 1, paragraph 10, lines 9-12).

Referring to claim 5, Penfield discloses registering with a window procedure with an operating system (page 2, paragraph 22, lines 7-11).

Referring to claim 8, Penfield discloses that the results window comprises a pop-up window (reference number 210, Figure 2).

Referring to claim 9, Penfield discloses that the results window comprises a hover help window (page 4, paragraph 35, lines 1-5).

Referring to claim 10, Penfield discloses that the results window comprises a clipboard (reference number 210, Figure 2).

Referring to claim 12, Penfield discloses a computer program product, which includes a program configured to carry out the functionality claimed (page 5, paragraph 59). Penfield discloses a program configured to perform a method of displaying summary information about a list of elements and receiving a selection of at least one desired summary function (page 1, paragraph 9, lines 6-8). Penfield discloses receiving a selection of a list of elements and calculating the at least one desired summary function using the list of desired elements to generate summary information (page 1, paragraph 10, lines 1-12). Penfield discloses displaying the summary information in a results window (page 1, paragraph 10, lines 7-9). Penfield discloses a signal bearing media bearing the program (page 5, paragraph 58, lines 5-8).

Referring to claim 13, Penfield discloses that the program product comprises an operating system (page 5, paragraph 59, lines 1-4), where the computer system includes an operating system where the program product is stored.

Referring to claim 14, Penfield discloses that the program comprises a word processing program (page 5, paragraph 57, lines 4-7), where word processing capabilities are implemented within the program.

Referring to claim 15, Penfield discloses that the program comprises a web browser (page 5, paragraph 58, lines 1-6).

Referring to claim 16, Penfield discloses that the program comprises a plug-in (page 5, paragraph 58, lines 1-2).

Referring to claim 17, Penfield discloses that the signal bearing media is

chosen from the group consisting of information permanently stored on non-writable storage media, alterable information stored on writable storage media and information conveyed to a computer by a communications medium. See page 5, paragraphs 58 and 59.

Referring to claim 20, Penfield discloses that the elements are non-contiguous (page 4, paragraph 37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 6, 7, 11, 18, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penfield and U. S. Publication No. 2002/0124016 A1 (Rank et al.), herein referred to as Rank.

Referring to claims 2 and 18, Penfield does not disclose a configuration file. Rank discloses generating a configuration file containing spreadsheet information including summary functions (page 1, paragraph 2, lines 2-3). Rank also discloses parsing the configuration file to extract the desired information including function data (page 5, paragraph 47). It would have been obvious to one skilled in the art at the time of the invention to learn from Rank to include configuration file, which stores the desired information. Rank discloses the need for such a configuration file and manipulation within this file to extract desired data in use with PDAs where memory storage is an

issue (page 3, paragraph 25). Penfield has disclosed that the system of Penfield can be incorporated into any computer system including a PDA (page 5, paragraph 58). The need for a configuration file and manipulation within this configuration file would have been an obvious teaching in view of the motivation where such a configuration file is efficient when working with spreadsheet applications in PDA systems. Therefore, one skilled in the art would have been motivated to learn from Rank to include configuration file which stores the desired information including the copied list of data values and other data related to the spreadsheet including summary functions.

Referring to claim 3, Penfield and Rank disclose that the configuration file comprises at least one field chosen from the group consisting of a library name, a function name field, and a display name field (Rank, page 2, paragraph 23, lines 15-25 and page 5, paragraph 47, lines 9-11).

Referring to claim 6, Penfield does not disclose copying the list of elements into a temporary memory structure. Rank discloses copying spreadsheet data including the list of data values or numbers into a memory address (page 4, paragraphs 42 and 43). It would have been obvious to one skilled in the art at the time of the invention to learn from Rank to copy list of data values and other data related to the spreadsheet including summary functions into a memory structure. Rank discloses the need for such a configuration file and manipulation within this file to extract desired data in use with PDAs where memory storage is an issue (page 3, paragraph 25). Penfield has disclosed that the system of Penfield can be incorporated into any computer system including a PDA (page 5, paragraph 58). The data is stored in a memory structure

temporary to extract the necessary data. The need for a configuration file and manipulation within this configuration file would have been an obvious teaching in view of the motivation where such a configuration file is efficient when working with spreadsheet applications in PDA systems. Therefore, one skilled in the art would have been motivated to learn from Rank to copy list of data values and other data related to the spreadsheet including summary functions into a memory structure.

Referring to claim 7, Penfield does not disclose replacing the selected list of numbers with the summary information. Although Penfield discloses displaying the summary information to the user interface, Penfield does not disclose replacing the summary information. It is notoriously well known, in the art, at the time of the invention, to replace the selected list of numbers in the clipboard with the summary information. Examiner takes Official Notice of this teaching. It would have been obvious for one skilled in the art, at the time of the invention to replace the selected list of numbers with the summary information. It is well known in the art that clipboard data is replaced with one set of copied data with another set of copied data in this case being the list of elements replaced with the summary information. In view of this well known teaching, it would have been obvious to one skilled in the art at the time of the invention to replace the selected list of numbers with the summary information.

Referring to claim 11, Penfield discloses a method of displaying customizable summary information about a list of elements and receiving a selection of at least one desired summary function (page 1, paragraph 9, lines 6-8). Penfield discloses receiving a selection of a list of numbers and calculating the at least one desired summary

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function using the list of desired numbers to generate summary information (page 1, paragraph 10, lines 1-12). Penfield discloses displaying the summary information in a pop-up window (reference number 210, Figure 2). Penfield does not disclose replacing the selected list of numbers with the summary information. Although Penfield discloses displaying the summary information to the user interface, Penfield does not disclose replacing the summary information. It is notoriously well known, in the art, at the time of the invention, to replace the selected list of numbers in the clipboard with the summary information. Examiner takes Official Notice of this teaching. It would have been obvious for one skilled in the art, at the time of the invention to replace the selected list of numbers with the summary information. It is well known in the art that clipboard data is replaced with one set of copied data with another set of copied data in this case being the list of elements replaced with the summary information. In view of this well known teaching, it would have been obvious to one skilled in the art at the time of the invention to replace the selected list of numbers with the summary information.

Penfield does not disclose a configuration file and copying the list of numbers. Rank discloses generating a configuration file containing spreadsheet information including summary functions (page 1, paragraph 2, lines 2-3). Rank discloses copying spreadsheet data including the list of data values or numbers into a clipboard or memory address (page 4, paragraphs 42 and 43). Rank also discloses parsing the configuration file to extract the desired information including function data (page 5, paragraph 47). It would have been obvious to one skilled in the art at the time of the invention to learn from Rank to include configuration file which stores the desired

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information including the copied list of data values and other data related to the spreadsheet including summary functions. Rank discloses the need for such a configuration file and manipulation within this file to extract desired data in use with PDAs where memory storage is an issue (page 3, paragraph 25). Penfield has disclosed that the system of Penfield can be incorporated into any computer system including a PDA (page 5, paragraph 58). The need for a configuration file and manipulation within this configuration file would have been an obvious teaching in view of the motivation where such a configuration file is efficient when working with spreadsheet applications in PDA systems. Therefore, one skilled in the art would have been motivated to learn from Rank to include configuration file which stores the desired information including the copied list of data values and other data related to the spreadsheet including summary functions.

Referring to claim 19, Penfield does not clearly disclose that the signal bearing comprises a memory of a pervasive device. Rank discloses using a spreadsheet application in a pervasive device (page 2, paragraph 22). It would have been obvious to one skilled in the art at the time of the invention to learn from Rank to disclose that the signal bearing comprises a memory of a pervasive device. Penfield does disclose that the system of Penfield can be implemented in any kind of computer systems including a pervasive device. Therefore, it would have been obvious to one skilled in the art at the time of the invention to learn from Penfield to disclose that the signal-bearing medium comprises a memory of a pervasive device.

Referring to claim 21, Penfield discloses selecting at least one desired output

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function (page 1, paragraph 9, lines 6-8). Penfield discloses selecting of a list of elements and calculating the at least one desired output function using the list of desired elements to generate output information (page 1, paragraph 10, lines 1-12).

Penfield does not disclose transferring data into an application program. Rank discloses transferring information into an application program by copying the list of elements into a first addressable memory structure (page 5, paragraph 46 and page 4, paragraphs 42 and 43) and automatically transferring the output information into the application program (page 5, paragraph 47). The information that represents the spreadsheet data is compressed and transferred to the spreadsheet application program. It would have been obvious to one skilled in the art at the time of the invention to disclose transferring data into an application program. Rank has disclosed transferring of data into an application program, where the data is first compressed and manipulated and transferred into an application, which is run on a PDA system.

Penfield has disclosed that the system of Penfield can be incorporated into any computer system including a PDA (page 5, paragraph 58). The need for transferring of data into an application program with copying of spreadsheet data would have been an obvious teaching in view of the motivation where transfer of data is efficient when working with spreadsheet applications in PDA systems. Therefore, one skilled in the art would have been motivated to learn from Rank to disclose transferring data into an application program.

Conclusion

8. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach the method for displaying spreadsheet application data.

Responses to this action should be submitted as per the options cited below: The United States Patent and Trademark Office requires most patent related correspondence to be: a) faxed to the Central Fax number (571-273-8300) b) hand carried or delivered to the Customer Service Window (located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 CFR 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (571) 272-4054. The examiner can normally be reached on 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published


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in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Namitha Pillai
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Art Unit 2173
April 27, 2007



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